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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,336	02/28/2002	Dieter Kerner	39509-177800	5608
26694	7590	03/21/2006	EXAMINER	
VENABLE LLP			ROBERTSON, JEFFREY	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20045-9998			PAPER NUMBER	

1712

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

Office Action Summary	Application No. 10/084,336	Applicant(s) KERNER ET AL.	
	Examiner Jeffrey B. Robertson	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 4,7 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 5, 8, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laüfer et al. (U.S. Patent No. 4,022,152) in view of Mangold et al. (CA 2,223,377).

For claims 3, 5, 8, and 9, in column 8, lines 57-61, Laüfer teaches a pyrogenic silicic acid (SiO_2) is treated with octamethyltetrasiloxane. For claim 5, in column 3, lines 59-68, Laüfer discloses that the fillers produced are used in silicone rubbers for a greater thickening effect. Laüfer fails to teach that the pyrogenic silica is doped by aerosol. In col. 4, lines 39-43, Laüfer teaches that the treated fillers have hydrophobic character and are highly dispersed.

Mangold teaches pyrogenically produced oxides that are doped, including silicon dioxide on page 3, lines 18-22. On page 2, lines 5-22, Mangold teaches that the oxides are doped by aerosol. For claims 10 and 11, Mangold teaches that the dopant may be cerium and potassium salts. Page 3, lines 1-2.

Since both references teach that the treated oxides are used as fillers, it would have been obvious to one of ordinary skill in the art to select an effective amount of filler

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for the specific application as desired. In addition, since the fillers are doped and treated corresponding to applicant's claimed fillers, the examiner's position is that the fillers would be rapid dissolving.

Mangold and Laüfer are analogous art in that they come from the same field of endeavor, namely the use of pyrogenically prepared oxides as fillers. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the oxides in the treatment process of Laüfer. The motivation would have been that Mangold states that the doped pyrogenically prepared oxides have advantages over the non-doped oxides on page 15, lines 8-20 including an increase in thickening effect. One of ordinary skill in the art would have been motivated by the improvement in thickening effect in substituting the doped oxides of Mangold for the oxides used in Laüfer.

Response to Arguments

3. Applicant's arguments filed 2/13/06 have been fully considered but they are not persuasive.

Regarding the rejection under 35 U.S.C. §103(a) of claims 3, 5, 8, and 9 (and additionally, claims 10 and 11) as being unpatentable over Laüfer et al. (U.S. Patent No. 4,022,152) in view of Mangold et al. (CA 2,223,377), Applicant argues that neither reference suggests the advantages now set forth by Applicant in the claims. Applicant argues that the Laüfer reference clearly does not desire the presence of water. In response, the examiner does not find this argument to be persuasive because any water remaining in the doped oxide can be removed consistent with the disclosure of

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the Laüfer reference. Applicant also argues that the Mangold reference does not disclose the advantages of applicant's product. This argument is not persuasive because these advantages are disclosed in the Laüfer reference. See col. 4, lines 39-43 and col. 2, lines 4-16.

Applicant also argues that it is not clear why the Examiner insists that it is Applicant's burden to explain why the properties originally possessed by Mangold's products are not impacted by Laüfer's techniques or visa versa and that the Examiner's burden to establish a prima facie case of obviousness. In response, the examiner's position is that a proper case of prima facie obviousness is established as set forth in the rejection above. Applicant has argued that the products of each reference would be negatively impacted as a result of the combination of references. The Examiner is merely trying to understand why applicant believes this to be the case. Specifically, the references each describe the benefits of doping and surface-treating fillers. The motivation to combine the two references is that one of ordinary skill in the art would want to incorporate the benefits disclosed in each of the references. Applicant has not stated why one of ordinary skill in the art would not have a reasonable expectation of success in combining the two references and furthermore why one of ordinary skill in the art would believe the combination of the two references would negatively impact the benefits of each.

Applicant also argues that the Examiner has relied on the teachings of the instant specification resulting in a hindsight construction of applicant's claims. In response to applicant's argument that the examiner's conclusion of obviousness is

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based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant also argues that one of ordinary skill in the art would not have had the knowledge that the teaching of each reference would not have been negatively impacted. As set forth in the previous office action, one of ordinary skill in the art is only required to have a reasonable expectation of success and not "assurances of success." Given the benefits set forth in each reference, one of ordinary skill in the art would have had a reasonable expectation of success in combining the two references. Applicant's argument is not persuasive.

Last, Applicant argues that the Examiner has merely speculated as to improvements in transparency. The Examiner disagrees. The Examiner's position in this regard is not based on speculation but on conclusions that necessarily follow from the prior art. Specifically, the Laüfer reference emphasizes the highly disperse nature of surface-treated oxides. It necessarily follows that filler that is more uniformly dispersed in a polymer matrix would contribute to an improvement in transparency due to decreased agglomeration. Therefore, Applicant's argument is not persuasive.

Allowable Subject Matter

4. Claims 4, 7, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

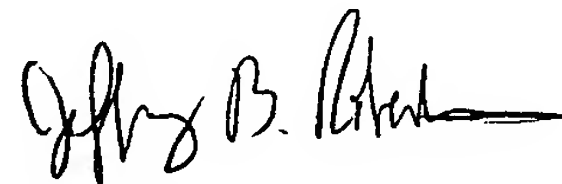
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson
Primary Examiner
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JBR